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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,830	01/22/2002	Heinrich Lang	LMX-69-CON	6532
22827	7590	03/16/2004	EXAMINER	
DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			SHAVER, RICKY D	
		ART UNIT		PAPER NUMBER
		2872		

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/053,830	LANG ET AL.	
	Examiner	Art Unit	
	Ricky D. Shafer	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 December 2003.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 and 11-25 is/are pending in the application.
  - 4a) Of the above claim(s) 2-6 and 11-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 Decemeber 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Newly submitted claims 18-24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The [newly submitted] and [elected] inventions are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the evidence of original claims 2, 3, 5 and 11. The subcombination has separate utility such as an rearview mirror assembly without a an adjustment mechanism, a clamp receptacle, clamping wedge, a snap-in detent apparatus or cover. Thus, claim 18 is directed to invention I, claims 19 and 20 are directed to invention II, claims 21 and 22 are directed to invention III and claims 23 and 24 are directed to invention V.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

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section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sillmann ('925).

Sillmann discloses a rearview mirror assembly comprising a support structure having a first part (9) and a second part (19) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm (33) having a mirror (7) and a key activated locking mechanism (22 and 25-27) including a key cylinder (25,26) and a latch member (22) disposed on the support structure for selectively locking together the first and second parts of the support structure, note figures 8b and 9 along with associated description thereof, except for the key activated locking mechanism of the locking mechanism being disposed on the first part of the support structure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange and/or reverse the location of locking mechanism of Sillmann such that the key activated locking mechanism including a key cylinder (25,26) and a latch member (22) is positioned on the first part of the support structure, instead of being located the second part of support structure, in order to increase stability, since it has been held that rearranging parts and/or the mere reversal of parts of an invention involves only routine skill in the art. Note In re Japikse, 86 U.S.P.Q. 70; In re Einstein, 8 U.S.P.Q. 167; and In re Kuhle, 188 U.S.P.Q. 7.

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As to the limitation that the latch member is hook-shaped, it is well known to use hook-shaped latches in an analogous art of locking mechanisms for the purpose of preventing unauthorized entry/removal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the latch member of Sillmann to include a hook, as is commonly used and employed in lock art, in order to increase the strength of the locking mechanism.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,554,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (10/053,830) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 6,554,436 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

U.S. Patent ('436) discloses a rearview mirror assembly for a vehicle comprising a support structure including a first part (clamp receptacle) and a second part (insertable component) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm having a mirror and a key activated locking mechanism disposed on the support structure for selectively locking together the first and second parts of the support structure, except for the key activated locking mechanism includes a key cylinder and a hook shaped latch member.

It is well known to use key activated locking mechanisms having a key cylinder and a hook shaped latch member in an analogous art of locking mechanisms for the purpose of preventing unauthorized entry/removal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the key activated locking mechanism of U.S. Patent ('436) to include a typical key cylinder and hook latch member, as is commonly used and employed in the

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lock art, in order to prevent unauthorized removal of the support arm and mirror.

6. Claims 1 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,352,231. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (10/053,830) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 6,352,231 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

U.S. Patent ('231) discloses a rearview mirror assembly for a vehicle comprising a support structure including a first part (clamp reception fixture) and a second part (insertable component) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure serves as a support arm for a rearview mirror and a locking device having a locking cylinder and a detent hook disposed on the support structure for selectively locking together the first and second parts of the support structure, except for the locking device includes a key activated locking mechanism.

It is well known to use key activated locking mechanisms having a key cylinder and a hook shaped latch member in an analogous art of locking mechanisms for the purpose of preventing unauthorized entry/removal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the locking device of U.S. Patent ('231) to include a typical key

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activated locking mechanism, as is commonly used and employed in the lock art, in order to prevent unauthorized removal of the support arm and mirror.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication should be directed to R. D. Shafer at telephone number (571) 272-2320.

RDS

08 March 2004

*R. D. Shafer*  
RICK D. SHAFER  
FEBRUARY 2872